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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,153	01/13/2006	Stephane Lefort	J7164(C)	9751

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EXAMINER	
SUTTON, DARRYL C	

ART UNIT	PAPER NUMBER
1612	

MAIL DATE	DELIVERY MODE
04/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/543,153	LEFORT ET AL.	
	Examiner	Art Unit	
	DARRYL C. SUTTON	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07/22/2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☒ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/21/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112 & 101

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 provides for the use of perlite, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5, 6, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vernon (US 5,976,506).

Vernon teaches oral care products such as toothpastes comprised of agglomerates which are made of at least two, chemically and/or physically different particulate materials (Abstract). The particulate materials such as perlites and silicas can be used in the composition (column 2 lines 60-65). The amounts of particulate materials in the agglomerates may vary from 70-100% by weight of the agglomerate (column 2, lines 52-54). The agglomerates are present in the composition in an amount of from about 1 to about 99% by weight (column 4, lines 54-56). The compositions comprise additional abrasive cleaning agents in an amount of 5-60% by weight, such as chalks (column 6, lines 19-23). The agglomerates break under shear and or crush forces, the reduced particle size will impart a feeling of polished teeth (column 3, lines 53-59).

Vernon does not teach a specific embodiment comprised of perlite and chalk.

The specific combination of features claimed is disclosed within the broad generic ranges taught by the reference but such "picking and choosing" within several

variables does not necessarily give rise to anticipation. Corning Glass Works v. Sumitomo Elec., 868 F.2d 1251, 1262 (Fed. Circ. 1989). Where, as here, the reference does not provide any motivation to select this specific combination of variables (particulate materials and additional abrasive cleaning agents), anticipation cannot be found.

That being said, however, it must be remembered that "[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious". KSR v. Teleflex, 127 S,Ct. 1727, 1740 (2007)(quoting Sakraida v. A.G. Pro, 425 U.S. 273, 282 (1976)). "[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious", the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." (Id.). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." KSR v. Teleflex, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that "[a] person of ordinary skill is... a person of ordinary creativity, not an automaton." Id. at 1742. Consistent with this reasoning, it would have obvious to have selected various combinations of various disclosed ingredients, perlites and chalk, from within a prior art disclosure, to arrive compositions "yielding no more than one would expect from such an arrangement".

In regards to claims 2 and 3, the prior art does not teach an embodiment comprised of the weight percentages of both perlite and chalk. The prior art does not disclose the exact claimed values, but does overlap: in such instances even a slight overlap in range establishes a *prima facie* case of obviousness. In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). The prior art teaches ranges of agglomerates of from about 1 to about 99% by weight; and amounts of particulate materials such as perlite in the agglomerates may vary from 70-100% by weight; this corresponds to an amount of perlite in the oral composition of 0.7% to 99% by weight. The instant claims limit the amount to 0.01 to 20% by weight of perlite.

In regards to claims 5-7, the compositions of Vernon et al. encompass compositions which have substantially the same components in the same amounts as those of the instant application and therefore it is reasonably expected that these embodiments would have a pH of 8-14, a RDA of 140-170, and a percentage polish of 60-95.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vernon et al. as applied to claims 1-3, 5, 6, and 7 above, and further in view of Riley et al. (WO 2003/030850).

Vernon et al. is discussed above.

Vernon et al. do not teach that the chalk is fine ground natural chalk.

Riley et al. teach an oral composition comprising 1 to 60% by weight of fine ground natural chalk (Abstract). Chalk is a common abrasive in oral care formulations;

one of the main advantages over other abrasives is that it is relatively cheap (page 1, lines 6-10).

It is prima facie obvious to select a compound based on its suitability for its intended use. See MPEP 2144.07. Accordingly, it would have been obvious to use the fine ground natural chalk of Riley et al. in the composition of Vernon et al. as a source of chalk abrasive.

All claims are rejected.

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darryl C. Sutton whose telephone number is

(571)270-3286. The examiner can normally be reached on M-Th from 7:30AM-5:00PM EST and on Fr from 7:30AM-4:00PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached at (571)272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Darryl C Sutton/
Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612